



09 JUL 2008

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In re Application of MAY	:	
U.S. Application No.: 10/529,326	:	
PCT Application No.: PCT/EP2003/010634	:	
Int. Filing Date: 24 September 2003	:	DECISION
Priority Date Claimed: 25 September 2002	:	
Attorney Docket No.: 119508-00282	:	
For: TORQUE SIGNAL TRANSMISSION	:	

This is in response to applicant's "Third Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 20 February 2008.

BACKGROUND

On 24 September 2003, applicant filed international application PCT/EP2003/010634, which claimed priority of an earlier United Kingdom application filed 25 September 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired on 25 March 2005.

On 25 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 31 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 October 2005, applicant filed a petition under 37 CFR 1.47(b).

On 23 June 2006, this Office mailed a decision dismissing the 28 October 2005 petition.

On 26 December 2006, applicant filed a renewed petition under 37 CFR 1.47(b).

On 02 April 2007, this Office mailed a decision dismissing the 26 December 2006 petition.

On 04 June 2007, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 20 August 2007, this Office mailed a decision dismissing the 04 June 2007 petition.

On 20 February 2008, applicant filed the present third renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (3), (4), and (6) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition stats that the sole inventor Lutz May refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to May for signature (see statement of Brian Higgins on page 3 of the 26

December 2006 petition and 30 May 2007 affidavit of Alexander Strauss, ¶3). Furthermore, the petition sufficiently establishes that May refuses to sign. Specifically, May's failure to supply an executed declaration in response to the letter dated 24 August 2005 constitutes a constructive refusal to cooperate (see translation of 24 August 2005 letter and May's response dated 30 August 2005). Thus, it can be concluded with reasonable certainty that May refuses to sign the application papers.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

Although the decision mailed 02 April 2007 stated that item (5) has been satisfied, a review of the submitted evidence reveals that further consideration is required.

The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has shown that on 22 August 2003, Fast Technology AG ("Fast") sold the present invention to Magna-lastic Devices, Inc. ("Magna-lastic") (see Exhibit C). The memorandum of Klaus Gennen states that Magna-lastic assigned the rights to the present invention to Abas (see Gennen memorandum, ¶25). Petitioner has supplied a copy of an assignment agreement which indicates that Fast assigned the present invention to Abas in June 2004. However, petitioner has not explained how the assignment from Fast to Abas was executed after rights to the invention were sold to Magna-lastic. Furthermore, petitioner has not established that Fast obtained rights to the invention from inventor May.

In the present case, the legal memorandum of Klaus Gennen states that Magna-lastic or Abas would be awarded title of the present invention by a court of competent jurisdiction. However, the memorandum's conclusion is based on the alleged fact that May made the present invention during the time and scope of his employment by Fast (see Gennen's memorandum, ¶¶11-14). The 20 November 2007 affidavit of Stephen Harders included with the present renewed petition does not establish that Mr. Harders personally observed Mr. May making the present invention during his employment with Fast. The mere fact that May might have been employed by Fast at the time of the filing of the priority application does not demonstrate on a personal knowledge basis that the present invention was made during the time and within the scope of May's employment. Additionally, the present petition fails to include a copy of the German court decision referenced in the petition filed 26 December 2006. Any legal memorandum submitted in support of the 37 CFR 1.47(b) petition must address such German court decision in drawing any legal conclusion.

CONCLUSION

For the reasons above, the third renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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